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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/608,419 | 06/30/2003 | Randal A. McCoy | 3350-0120 | 8084 |
| 20457 | 7590 | 06/25/2004 | EXAMINER | |
| ANTONELLI, TERRY, STOUT & KRAUS, LLP | | | PAIK, STEVE S | |
| 1300 NORTH SEVENTEENTH STREET | | | ART UNIT | PAPER NUMBER |
| SUITE 1800 | | | | |
| ARLINGTON, VA 22209-9889 | | | 2876 | |

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/608,419 | MCCOY ET AL. <i>An</i> | |
| | Examiner | Art Unit | |
| | Steven S. Paik | 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 June 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 June 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2/18/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-14 recite the limitation "the service provider" in line 3. There is insufficient antecedent basis for this limitation in the claim. The limitation is first introduced in line 3. Hence, the examiner believes it should be -- a service provider -- to avoid the issue of lacking a proper antecedent basis. Dependent claims 2-14 are rejected due to their dependent relationship.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation, "the payor" in line 7 of Claim 11 is unclear whether it is a payor or a second payor. The lack of an art rejection of claim 11 is not an indication of allowable subject matter (i.e., even though the claim 11 is rewritten or amended to overcome the rejection under 35 U.S.C. 112 as discussed above). The disclosure/claimed language is such that it is impractical to conduct a reasonable search of the prior art by the Examiner.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation, "the payor" in line 5 of Claim 20 is unclear whether it is referring "a payor" or "a second payor". The lack of an art rejection of claim 20 is not an indication of allowable subject matter (i.e., even though the claim 20 is rewritten or amended to overcome the rejection under 35 U.S.C. 112 as discussed above). The disclosure/claimed language is such that it is impractical to conduct a reasonable search of the prior art by the Examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1, 2, 4, 8-10, 13, 15, 16, 19, and 21 are rejected under 35 U.S.C. 102(a) as being anticipated by applicant's admitted prior art (AAPA).

Re claims 1 and 10, and 15, AAPA discloses a method and system for directing a credit card based payment to a payee on behalf of a payor having a credit card issued by a credit card issuer (4th paragraph on page 1 under the heading of Background Of The Invention) comprising:

receiving a request for the service provider to direct a payment to a payee on behalf of the payor;

transmitting payment information (via several electronic user interfaces listed in the 4th paragraph) associated with the received payment request to the credit card issuer via other than a credit card network (telephone network, Internet, wireless, or cable based network), the payment information including information identifying at least a payment amount (4th paragraph on page 1) and information identifying an account number associated with the payor credit card (specifying a payer possibly indirectly);

receiving, by the service provider and via other than a credit card network (one of the network specified above), funds from the credit card issuer responsive to the transmitted payment information (payment); and

delivering, by the service provider, funds and remittance advice to the payee

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to complete the payment on behalf of the payor (at the conclusion of payment processing, the service provider issues remittance to a payee. Remittance is a combination of a credit to a payee and remittance advice associated with the credit. If the communication interface is a PC application-based interface, it inherently includes a processor such as a CPU that controls the PC application-based interface.

Re claims 2 and 16, AAPA discloses the method as recited in rejected claims 1 and 15 stated above, further includes information identifying the payee (possibly by reference).

Re claim 4, AAPA discloses the method as recited in rejected claim 1 stated above, wherein the funds are delivered to the payee by one of a paper instrument and an electronic funds transfer; and

if the funds are delivered by electronic funds transfer, the funds are delivered via an electronic funds transfer network to a deposit account associated with the payee maintained at a financial institution (6th paragraph).

Re claim 8, AAPA discloses the method as recited in rejected claim 1 stated above, wherein the funds are received from the credit card issuer via the ACH network (7th paragraph).

Re claim 9, AAPA discloses the method as recited in rejected claim 1 stated above, wherein the funds are delivered to the payee at one of a time prior to, concurrent with, or subsequent to receipt of the funds from the credit card issuer (6th and 7th paragraph).

Re claims 13, 19 and 21, AAPA discloses the method as recited in rejected claims 1 and 15 stated above, wherein the payee does not accept credit card as a form of payment (a credit may be performed through a paper process such as check or draft; 6th paragraph).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 5-7, 12, 17, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Kramer et al. (US 6,327,574).

Re claim 3, 5, 6, 12, 17 and 18, AAPA discloses a credit card transaction. However, the disclosure is silent about a credit card statement, the credit card being accepted by more than one payee, and the payor being associated with a consumer service provider.

Kramer discloses a pictorial example of an example structured document, here a credit card statement 200 (Fig. 2), and the types of information that may be usefully extracted during interpretation in order to update a consumer profile. The statement includes information identifying the a plurality of payees and other information about each transaction and the service/goods provider. The information may be used to build a unique consumer profile for each consumer for building more customized and personalized marketing strategy.

In view of Kramer teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ a credit card statement with the payee information among other transaction data in addition to the credit card payment method of AAPA due to the fact that more targeted marketing can be achieved for the purpose of maximizing convenience of a consumer and profitability of a card issuer.

Re claim 7, AAPA in view of Kramer discloses the method as recited in rejected claim 1 stated above, wherein the payment information is transmitted to the credit card issuer via the Internet (col. 5, ll. 1-24).

7. Claims 14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Pare, Jr. et al. (US 6,662,166).

The teachings of AAPA have been discussed above. AAPA does not explicitly disclose the claimed credit authorization request and approval steps.

Pare, Jr. discloses the credit authorization request and approval steps in Fig. 6 and 7. Furthermore, col. 15, ll. 18-67 discloses using a biometric sample or PIN for accessing authorization of a credit card transaction. The disclosed process obviously improves security of the credit card transaction.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the secure credit card transaction authorization process, as taught by Pare, Jr. to improve the security of the credit card transaction disclosed in applicant's admitted prior art.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Glaser (US 6,663,002) discloses a system and method for facilitating credit card transactions; Mersky et al. (US 6,611,818) discloses a method and apparatus for making credit card payments from a remote site.

9.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 571-272-2404. The examiner can normally be reached on Mon - Fri (5:30am-2:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven S. Paik
Examiner
Art Unit 2876

ssp